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EXAMINER

CHACE, CHRISTIAN

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/996,720
Filing Date: November 30, 2001
Appellant(s): SPENCER ET AL.

Thomas G. Bilodeau (43,438)
William T. Ellis (26,874)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 27 October 2005 appealing from the Office action mailed 27 June 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,000,006	Bruce et al	12-1999
2002/0107832 A 1	Shimizu et al	10-2001
6,478,679 B1	Himoto et al	12-2002
6,587,140 B2	No	07-2003
5,532,689	Bueno	07-1996

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:
(Relevant portions of the Final Office action of 22 June 2005 have been repeated herein for convenience).

Admitted Prior Art

It is important to note that claims 20-22 and 24-25 were rejected based on the examiner's assertion of official notice in the non-final Office action of 21 January 2005. Appellants' response on 19 April 2005 to that Office action did not contain a traversal of the facts taken as Official Notice. Accordingly, examiner noted MPEP 2144.03 (C), and clearly indicated in the final Office action of 22 June 2005 that the facts have been taken as admitted prior art. However, in the instant brief, Appellants have, for the first time, argued the facts taken as admitted prior art.

From Final action, 22 June 2005:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 14, 30, and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Bruce et al (US Patent 6,000,006).

With respect to independent claim 14, a data structure in a memory card, comprising, computer readable storage containing at least one event descriptor about usage of the memory card, and for each event descriptor a count representing the number of occurrences of that event is disclosed in the abstract as the write counts. Claims rejected supra discuss the write counts being stored on the memory card.

For each of a plurality of event descriptors an amount of memory used by an aggregation of events corresponding to a respective each of the event descriptors is disclosed in figure 6, #44, where the amount of

memory is the physical block being associated with the address in the mapping table shown.

With respect to independent claims 30 and 32, a method and apparatus for storing memory card usage information in a memory card is disclosed in the abstract. A memory card is disclosed, for example, in column 6, lines 40-41.

Collecting information about usage of the memory card and recording information about usage of the memory card in an area of the memory card is disclosed in the abstract.

Accessing the information about usage of the memory card from the memory card is disclosed in the abstract as well as in figure 6, which shows an arrow from the write counters, which shows them being "accessed." The write counters are stored in the memory card as discussed in column 6, line 45. (The counters are stored in the re-map table, which is stored in the flash card.)

Accessing the information about usage of the memory card from the memory card, wherein the information about usage of the memory card comprises the number of times data was "corrected" by the memory card is disclosed in column 5, lines 5-12, where data is corrected or kept correct, by wear-leveling based on the total number of writes to a particular section. This effectively keeps track of the number of times data was corrected by preventing it from having to be corrected, i.e., the

number of times data is corrected is zero. Examiner notes that the claim limitations are listed in the alternative (at least one of A and B), and, therefore, only requires one of the limitations of this section of the claim to be met in order to anticipate this section of the claim.

Claim 14 is rejected under 35 U.S.C. 102(b) as being anticipated by Shimizu et al (US Patent Application Publication #2002/0107832).

With respect to independent claim 14, computer readable storage is disclosed in figure 1, #726.

The storage containing at least one event descriptor about the usage of the memory card is disclosed in figure 4 as advertisement usage information.

A count representing the number of occurrences of that event is disclosed in figure 9, #S1205. Advertising usage information is "information about the usage of the memory card," as discussed supra with respect to claim 1. Paragraph 98 discloses changing a count as, "updat[ing] the number of accesses to the web (recorded in advertisement usage information)." Access to the web is "the event," and the number of times the web is accessed is the "event descriptor" that counts the number of times the event occurs.

An amount of memory being used by an aggregation of events corresponding to respective each of the event descriptors (see supra) is

inherent – if data of any kind is to be saved, there must be a place to save it. Also, figure 5 shows a table that relates to the 2nd content identifier of figure 4, as also discussed supra with respect to claim 9. In other words, figure 5 is a table that represents an amount of memory being used by an aggregation of the events corresponding to the respective content identifier (2nd content identifier).

Claims 23-26 and 30-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Himoto et al (US Patent #6,478,679).

With respect to independent claim 23, examiner must first point out that “storing the usage of the memory card on the memory card” has been interpreted as storing the usage of the memory card *in* the memory of the card. Also, “usage of the memory card” is very broad, and may comprise any number of things, for example, as discussed supra with respect to claim 1. In this case, examiner has interpreted “usage of the memory card” as the type of games stored and the respective scores, for example, as shown in figure 7, 8A, and 8B, as they are activities stored on the card that are used by the card.

These figures also show a portable memory card, as discussed in the abstract.

As storing the usage activities is shown as discussed supra, inherently those activities are “monitored” if they are stored. For example,

the score is recorded with the game title. Therefore, the game is “monitored” by keeping track of the score.

Displaying the usage activity on the memory card is shown in figure 3 as a LCD. This is also discussed in the abstract, for example.

With respect to claims 24-25, displaying the usage IN a window on the memory card or on a screen on the memory card are disclosed, as discussed supra, in figures 7 and 8, which show LCD 14 of figure 3, discussed supra with respect to claim 23.

With respect to claim 26, monitoring the amount of remaining free space on the memory card is disclosed in figures 5 and 6 as “Empty Region.”

With respect to independent claims 30 and 32, collecting information about usage of the memory card is disclosed in figures 7, 8A, and 8B, for example. “Usage of the memory card,” is interpreted by examiner to mean the games played using the memory card, #10. The information collected are the games.

Recording the information about usage of the memory card in an area of the memory card is also disclosed in figures 7, 8A, and 8B, for example. As discussed in column 12, lines 37-38, a list of stored data is shown. The data being stored, or recorded, on the memory card 10 is discussed in column 12, line 49.

Accessing the information about usage of the memory card from the memory card is disclosed in column 12, lines 44-46, the particular game is selected, thereby accessing the information about the usage of the memory card.

The information about usage of the memory card comprising at least one of a measurement of how full the memory card is and the number of times data was corrected by the memory card is discussed in column 10, lines 64-67, as shown in figures 5A-E and 6A-C, for example, which shows how full the memory card is. As applicants have not claimed whether this is a quantitative or qualitative measurement, examiner has interpreted the display of the figures to be a qualitative measurement, as the user can see about how much of the memory is full. Examiner notes that the instant claim language of "at least one of," merely requires one of the two possible limitations to be anticipated to anticipate the entire limitation.

Examiner notes that claim 30 is a method claim that is anticipated by the instantly cited prior art of record. Accordingly, apparatus to perform the anticipated method (claim 32) is also anticipated, as discussed supra with respect to claims 1 and 16.

With respect to claims 31 and 33, the information about usage of the memory card comprising a measurement of how full the memory card

is disclosed as discussed supra with respect to claims 30 and 32, respectively.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 8-9, 12-13, 16-17, 23, and 26 are rejected under 35 U.S.C. 103(a) as obvious over Bruce et al (US Patent 6,000,006).

With respect to independent claims 1, as well as 16 and 17, Bruce et al disclose a method and apparatus for storing memory card usage information in a memory card is disclosed in the abstract. A memory card is disclosed, for example, in column 6, lines 40-41.

Collecting information about usage of the memory card and recording information about usage of the memory card in an area of the memory card is disclosed in the abstract.

Accessing the information about usage of the memory card from the memory card is disclosed in the abstract as well as in figure 6, which shows an arrow from the write counters, which shows them being "accessed." The write counters are stored in the memory card as

discussed in column 6, line 45. (The counters are stored in the re-map table, which is stored in the flash card.)

Displaying the information about the usage of the memory card on a display on the memory is printed matter not functionally related to the memory card's method of operation. Writing the results of the previous steps and apparatus, as disclosed by Bruce et al, on the storage media on a sticker on that storage media is a mental step completed via a pen and paper.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention, having the teachings of Bruce et al before him/her, to keep track of the number of writes on a flash memory on a sticker on the flash memory, in order to keep track of how many times the memory has been written to, in order to provide even wear, as disclosed by Bruce et al in the abstract, for example. By simply writing on a sticker on the memory slash marks, e.g., one could keep track of how many times the memory has been written without having to add all of the circuitry, thereby reducing the manufacturing costs, e.g.

In addition, it is well settled that if the difference between the claimed invention and the prior art lies solely in the printed matter, then this difference cannot patentably distinguish over the prior art unless the printed matter is functionally related to the substrate. See MPEP 2106, *In*

re Gulack, 217 USPQ 401, CAFC 1983; Ex parte Breslow, 192 USPQ 431, BdPatApp&Int 1975.

With respect to claim 2, “monitoring” write events is disclosed in the abstract. “monitoring” is defined as keeping watch over. Inherently, by counting the number of writes, the system is keeping watch over those write events. Monitoring read events is disclosed in column 7, line 35. Monitoring power-on events is inherent in light of the definition of monitoring discussed herein – power must be applied for the system to work. If power is applied, it is monitored.

With respect to claim 3, changing a count associated with an event descriptor when an event occurs is disclosed in the abstract as a write count.

With respect to claim 4, storing a “value parameter” associated with said event descriptor when said event occurs is disclosed in the abstract as a write count.

With respect to claim 5, changing a running total associated with said event descriptor when said event occurs is disclosed in column 7, lines 10-11 and in figure 6, #46 as a total write count.

With respect to claim 6, recording information about usage in a dedicated area in said memory card is disclosed in column 6, line 47 as well as in figure 6, #46.

With respect to claim 8, changing a count associated with an event description when the event occurs is disclosed as incrementing the counter in column 3, lines 5-15. Displaying the count is disclosed in figure 6, #46. The count is “displayed” to the wear-level controller, e.g.

With respect to claim 9, a plurality of event descriptors are disclosed in figure 6, #46 and #48, e.g. Displaying them is disclosed in figure 6, #46 and #48, as discussed supra with respect to claim 8. Each of the plurality of event descriptors being “selectable” is disclosed in column 3, lines 17-23, where they are “selected” by the logical address, e.g. Additional “usage information” being displayed upon selection associated with the respective event descriptor is disclosed in figure 6, #52 – the valid bit.

With respect to claim 12, creating write and read commands allowing the host to store the information about usage and reading that information is inherent in the system of Bruce et al. A computer must be told what to do – see figures 4 and 6, e.g.

With respect to claim 13, changing a count associated with an event descriptor when the event occurs, comparing the count to a threshold, and, if the threshold is equaled or exceeded, then causing a message to be sent is disclosed in column 13, lines 20-25.

With respect to independent claim 23; claims 1 and 8, as addressed supra, anticipate/render obvious the claim limitations as discussed supra with respect to same.

With respect to claim 26, monitoring an amount of memory used in the memory card, and monitoring an amount of memory remaining free on the memory card is disclosed as keeping track of whether given sections of memory have been wear-leveled or not by counting the total number of writes ever written to that memory area, as discussed in column 10, lines 30-32.

Claims 1-6, 8-9, 12-13, 16-17, and 20-22 are rejected under 35 U.S.C. 103(a) as obvious over Shimizu et al (US Patent Application Publication #2002/0107832).

With respect to independent claims 1 and 16, a method and system for storing memory card usage information on a memory card is disclosed in the title as an apparatus and method for outputting control information. Examiner interprets "information about usage of the memory card" to be any data that has to do with how the memory card is used. A memory card is disclosed in paragraph 59 as control information storage unit, #726 in figure 1.

Collecting information about the usage of the memory card is disclosed in paragraphs 59 and 61 as generating use condition information and billing information, as well as advertisement usage

information (which is based on the content selected and stored on the memory card – see paragraph 65, for example), which is also stored in control information storage unit 726, as discussed in paragraph 67.

Recording the information about usage of the memory card in an area of the memory card is disclosed in paragraph 61 as the generated use condition information and the billing information being recorded in the control information storage unit 726.

Accessing the information about usage is disclosed in paragraph 61 as, “using the generated use condition information.” If the information is “used,” it is inherently “accessed.”

Displaying the information about the usage of the memory card on a display on the memory is printed matter not functionally related to the memory card’s method of operation. Writing the results of the previous steps and apparatus, as disclosed by Shimizu et al, on the storage media on a sticker on that storage media is a mental step completed via a pen and paper.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention, having the teachings of Shimizu et al before him/her, to keep track of how many times the user can use the card to rent movies. By simply writing on a sticker on the memory slash marks, e.g., one could keep track of how many times the card has been used

without having to add all of the circuitry, thereby reducing the manufacturing costs, e.g.

In addition, it is well settled that if the difference between the claimed invention and the prior art lies solely in the printed matter, then this difference cannot patentably distinguish over the prior art unless the printed matter is functionally related to the substrate. See MPEP 2106, *In re Gulack*, 217 USPQ 401, CAFC 1983; *Ex parte Breslow*, 192 USPQ 431, BdPatApp&Int 1975.

With respect to claim 2, figure 6 is an example of the generated use condition information, which discloses "number of times reproduction is possible," ("monitoring" write events), "whether copying is allowed," ("monitoring" read events – the data must inherently be read in order to be copied. In other words, if it is not read, it cannot be rewritten as the copy) and "monitoring" power-on events, which is inherent in that if the card collects usage information about the card in an area of the card, as discussed supra with respect to claim 1, then the card must, inherently, be powered on for those transactions, and by "monitoring" the transactions, power-on events are also inherently "monitored." "Monitoring" is interpreted by examiner as the system "being aware" of the transaction. By performing the transaction, the system must, inherently, be aware of it.

With respect to claim 3, the collecting step comprising changing a count associated with an event descriptor when the event occurs is

disclosed in figure 9, #S1205. Advertising usage information is "information about the usage of the memory card," as discussed supra with respect to claim 1. Paragraph 98 discloses changing a count as, "updat[ing] the number of accesses to the web (recorded in advertisement usage information)." Access to the web is "the event," and the number of times the web is accessed is the "event descriptor" that counts the number of times the event occurs.

With respect to claim 4, the collecting step further comprising storing a "value parameter" associated with said event descriptor when the event occurs is disclosed in figure 4, and discussed supra, as the "number of times (the website is accessed)."

With respect to claim 5, the collecting step comprising changing a running total, or count, associated with said event descriptor when the event occurs is disclosed in paragraph 98 as discussed supra with respect to claim 3.

With respect to claim 6, recording the information about usage in a dedicated area in said memory card is disclosed in figure 4, for example. Also, this is inherent in that all data stored in a computer memory is in a "dedicated" area – that area is dedicated to whatever data is stored there.

With respect to claim 8, changing a count associated with an event description when the event occurs, and wherein the accessing step comprises displaying the count is disclosed in figure 4, and the

“displaying” is discussed in paragraph 62 into 63. Paragraph 62 discusses the use condition information, explained supra with respect to claim 1, for example. Paragraph 63 discusses the fact that the use condition information contains more particular information, which *shows a user* instruction on how many times the rented digital content may be reproduced, for example. If instructions are being “shown” to a user, they must be “displayed” – this is inherent.

With respect to claim 9, a plurality of event descriptors is disclosed in figure 4. As discussed supra with respect to claim 3, the advertisement usage information contains an “event descriptor,” of which “No. times web site is accessed,” was specifically mentioned. However, figure 4 discloses a plurality of “event descriptors,” such as, “number of times 2nd digital content is reproduced.” Displaying these event descriptors is shown in figure 4, as well, and discussed in paragraph 57 as being provided by advertisement sponsors. Similar to examiner’s interpretation with respect to claim 8, in order to “provide” this information, it would have to be “displayed.” As the descriptor values are provided by the sponsors, they are “selectable.” Upon selection, paragraph 57 goes on to refer to a table, shown in figure 5, which is expressed in figure 4 as a “second [content] identifier.”

With respect to claim 12, creating “write and read commands” allowing the host to store the information about usage and read that

information is disclosed in paragraph 61. Write and read commands are inherent in write and read operations such as “record,” “input,” and “display” or “show”.

With respect to claim 13, changing a count associated with an event descriptor when the event occurs is disclosed as discussed supra with respect to claim 3.

Comparing the count to a threshold, and if the threshold is equaled or exceeded, then causing a message to be sent is disclosed in paragraph 10, with the “message to be sent” being “specifying a digital content identifier.” The threshold is the “certain number or more of second identifiers.”

With respect to independent claim 17, collecting information about usage of a portable memory card in an electronic device is disclosed in paragraph 61 as generating use condition information and billing information, as well as advertisement usage information (which is based on the content selected and stored on the memory card – see paragraph 65, for example), which is also stored in control information storage unit 726, as discussed in paragraph 67.

Recording the information about usage of the memory card in an area of the memory card is disclosed in paragraph 61 as the generated use condition information and the billing information being recorded in the control information storage unit 726.

Displaying the information about the usage of the memory card on a display on the memory is printed matter not functionally related to the memory card's method of operation. Writing the results of the previous steps and apparatus, as disclosed by Shimizu et al, on the storage media on a sticker on that storage media is a mental step completed via a pen and paper.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention, having the teachings of Shimizu et al before him/her, to keep track of how many times the user can use the card to rent movies. By simply writing on a sticker on the memory slash marks, e.g., one could keep track of how many times the card has been used without having to add all of the circuitry, thereby reducing the manufacturing costs, e.g.

In addition, it is well settled that if the difference between the claimed invention and the prior art lies solely in the printed matter, then this difference cannot patentably distinguish over the prior art unless the printed matter is functionally related to the substrate. See MPEP 2106, *In re Gulack*, 217 USPQ 401, CAFC 1983; *Ex parte Breslow*, 192 USPQ 431, BdPatApp&Int 1975.

With respect to claim 20, collecting information further comprising counting a number of times an image file was written to the memory card is disclosed in paragraph 2, as reproducing image data, which, as shown

in figure 4, is counted as the number of times the digital content may be reproduced (whether that digital content is image data or otherwise, it is still digital, and will be counted).

With respect to claim 21, the collecting information further comprising counting a number of times music files (audio data) were written to the memory card is disclosed in paragraph 2, as reproducing audio data, which, as shown in figure 4, is counted as the number of times the digital content may be reproduced (whether that digital content is audio data or otherwise, it is still digital, and will be counted).

With respect to claim 22, the collecting information further comprising tracking a number of times the memory card is formatted is disclosed in paragraph 61, as the user information is input by the clerk when the user first becomes a member of the rental store. The rental price (billing information) is calculated using the generated use condition information. Therefore, if the "format" changes, i.e., a different order is placed, so does the billing information, which is inherently "tracked," as it must be in order to "bill" the user.

Claims 20-22 and 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bruce et al (cited supra).

With respect to claims 24-25, Bruce et al disclose the claim limitations of the claim upon which the instant claims depend and/or include. Bruce et al additionally disclose the system firmware updating

the total and incremental write counts every 1,000 writes, e.g., in column 10, lines 31-32.

The difference between Bruce et al and the instant claim is the explicit recitation of displaying of the real-time information (the counts of Bruce et al are "real-time," and in a host system or "on" the memory card) in a window on a screen. It is important to note that the system of Bruce et al may be considered a memory card system, with a display "on" the memory card.

However, it is well known to those of ordinary skill in the art that a user may perform any of the functions that firmware can perform, and that to do so, the relevant information must be displayed for the user to see. The display being a screen or a window on a screen are known. Where the information is displayed is a mere matter of design choice. The examiner takes OFFICIAL NOTICE of this teaching.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention, having the teachings of Bruce et al before him/her, to display the real-time information of the write counts in order to allow a user to make the determinations made (wear-level every predetermined number of writes) by the firmware of Bruce et al, as made hackneyed in the state of the art.

Examiner notes that this has been taken as admitted prior art, as discussed supra, in accordance with MPEP 2143.03 (C.).

With respect to claims 20-22, Bruce et al disclose the write counters counting the number of writes for wear-leveling.

The difference between Bruce et al and the respective claim limitations is that the writes are image files, music files, or formats.

However, it is very well known in the art that music files, image files, and formatting require writes. The examiner takes OFFICIAL NOTICE of this teaching.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention, having the teachings of Bruce et al before him/her to count all writes to the memory for the purpose of wear-leveling to extend the life of the memory, as taught by Bruce et al.

Examiner notes that this has been taken as admitted prior art, as discussed supra, in accordance with MPEP 2143.03 (C.).

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shimizu et al (cited supra) and Bruce et al (cited supra), each taken separately; in view of Bueno (US Patent # 5,532,689).

Shimizu et al and Bruce et al, each taken separately, disclose the subject matter of the claims upon which the instant claim depends.

Shimizu et al and Bruce et al, each taken separately disclose collecting information.

The difference between Shimizu et al and Bruce et al, each taken separately; and the instant claim is the information collected further comprising counting physical insertions of the memory card in the electronic device.

Bueno discloses counting the number of times a memory card is inserted into an electronic device in the abstract as an access count.

Accordingly, it would have been obvious to one of ordinary skill in the art having the teachings of Shimizu et al and Beuno before him/her, to utilize the access counting of Bueno in the system of Shimizu et al and Bruce et al, each taken separately, as the access counting allows fraud prevention, as discussed by Bueno in column 3, lines 20-25.

Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Himoto et al (cited supra) and Bruce et al (cited supra), each taken separately; in view of No (US Patent #6,587,140).

Himoto et al and Bruce et al, each taken separately, disclose the subject matter of the claims upon which the instant claim depends.

Himoto et al disclose providing a portable memory card in a digital video game system. Bruce et al disclose a portable memory card as discussed supra.

The difference between Himoto et al and Bruce et al, each taken separately; and the instant claim is the memory card being in a digital camera.

No discloses a memory card for use in a digital camera.

Accordingly, it would have been obvious to one of ordinary skill in the art having the teachings of Himoto et al and Bruce et al, each taken separately; and No before him/her, to utilize the portable memory card of Himoto et al and Bruce et al, each taken separately; in the camera of No as it allows for a completely portable, untethered camera design, as disclosed by No in column 1, lines 40-43.

Response to Arguments

With respect to applicants' arguments that the cited prior art of record, as discussed in the previous Office action, does not anticipate or render obvious the instant claim language, examiner notes that many of these arguments are moot in light of the new grounds for rejection as necessitated by amendment.

Specifically, with respect to applicants' argument that Bruce does not disclose "displaying the information about the usage of the memory card on a display on the memory card, " examiner notes that this is anticipated and/or obvious in light of the fact that merely requires a sticker on the memory card upon which marks may be made as the card is used by a user for different things. As discussed supra, this does not constitute a patentable distinction.

With respect to applicants' argument that Bruce does not disclose "wherein for each of a plurality of event descriptors an amount of memory

used by an aggregation of events corresponding to respective each of the event descriptors,” examiner respectfully disagrees. Block addresses represent amounts of memory “corresponding to” event descriptors.

With respect to applicants’ argument that Bruce does not disclose “wherein the information about usage of the memory card comprises at least one of a measurement of how full the memory card is and the number of times data was corrected by the memory card,” examiner respectfully disagrees, and notes that the number o times data is corrected is zero, as a result of the wear-leveling, as discussed in the rejection. In addition, examiner directs applicants to a further discussion of the relationship between wear-leveling and ECC in columns 9 and 10 as they relate to figure 8 of Bruce et al.

With respect to applicants’ argument regarding Shimizu et al, examiner reiterates his responses throughout prosecution, as no new arguments have been presented. “Usage information” and “usage of a memory card” are very broad terms. To date, throughout the entire prosecution of the instant application, applicants still have not pointed to any definition in the instant specification, or even dictionary, but merely have discussed what the terms are not. This does not constitute a persuasive response.

(10) Response to Argument

To begin, appellants present arguments with respect to the outstanding objections to the drawings, "to the extent that the outstanding objection to the drawings need be addressed in this appeal." Examiner respectfully submits that outstanding objections to drawings are not appealable issues. See MPEP 1201. Appellants may seek remedy through a petition under 37 CFR 1.181(a)1, (c) and (f), decided by the Technology Center Directors (in this case TC 2100), but appellants are reminded of the 2-month period that is NOT extendable, as provided for and discussed in MPEP 1002.02 (c). As no relevant petition has been timely filed, the instant Answer has been forwarded to the Board of Patent Appeals and Interferences.

In addition, in the second paragraph of page 2 of the instant Brief, under the "Summary of Claimed Subject Matter" heading, appellants make the following assertion that Examiner wishes to particularly point out, as it goes to the heart of the issues in the instant disagreement. Appellants recite:

"The specification provides a number of examples of usage of a memory card, such as power-on events, write events, and read events (See p. 4, paragraph [0021], lines 2-7). The specification also distinguishes memory card usage information from other information such as customerID or resellerID information (See p. 8, paragraph [0032])."

Specifically, examiner respectfully disagrees that the cited paragraphs nor the rest of the instant specification – indeed, the entire disclosure as filed – distinguish

Art Unit: 2189

"memory card usage information" from anything else. Mere recitation of examples cannot be considered limiting in this case. Examiner will, of course, elaborate in much greater detail below in the course of addressing each and every argument presented in the instant Brief.

A. The rejections of claims 14, 30, and 32 under 35 USC 102(b) as being anticipated by Bruce et al

1. Claim 14

With respect to appellants' argument that element 44 of figure 6 of Bruce et al fails to anticipate an amount of memory used by an aggregation of events corresponding to each respective event descriptor, examiner respectfully disagrees. An event is a write. Figure 6 shows the write counts for one block of memory, the block being indicated by the block address. Figure 5 clearly shows that there are more than one block of memory, thereby producing an aggregation of the write events. Accordingly, it appears appellants may have misunderstood the respective rejection, as the address itself does not equate to the amount, but the block it represents is the actual amount. It is important to note that the instant specification does not appear to offer any special definitions of what "an amount" is. Accordingly, examiner respectfully submits that claim 14 is anticipated by Bruce et al.

2. Claims 30 and 32

With respect to appellants' argument that Bruce et al fail to disclose the number of times data was corrected on a memory card, examiner respectfully disagrees. Bruce et al do indeed teach preventing data from having to be corrected, and this does teach,

Art Unit: 2189

“accessing information regarding a number of times data is corrected from any memory card.” The number of times data is corrected is zero, as correction is prevented.

Access to this information is available through simple operation of the Bruce et al device, as the data will need to be corrected zero times.

B. The rejection of claim 14 under 35 USC 102(b) as being anticipated by Shimizu et al

1. Claim 14

With respect to appellants' argument that Shimizu et al do not disclose “information about the usage of a memory card” in the manner recited in the claims, and examiner's interpretation about usage of a memory card is not reasonable, examiner respectfully, but most strenuously, disagrees.

Appellants specifically assert that the advertisement usage information which is stored on the memory card, the number of times a website has been accessed which is stored on the memory card, use condition information and billing information which is stored on the memory card, as well as reproduction information stored on the memory card, cannot be reasonably interpreted to be information about usage of the memory card. However, all of that information is stored on the memory card because it relates to how that memory card has been and will be used. The memory card is used in the process of renting a DVD, for example. That would be usage of the memory card. The information about it is each and/or all of the parameters that guide how that card may be used. Accordingly, Shimizu et al do, indeed, anticipate the instant claim language.

Appellants assert that the claim language must be given the broadest reasonable interpretation consistent with the specification. Examiner could not agree more. MPEP 2111 clearly discusses this fact. It is the "consistent with the specification" phrase that appears to be particularly at issue instantly.

When an examiner begins examination of the claims in an application for letters patent, examiner reads the claims and attempts to determine the scope of those claims. (MPEP 2106 (II) C. and MPEP 2111.01(II and III)).

In this process, examiner first consults the intrinsic evidence of record, which is the instant application itself. It is always necessary to review the specification to determine whether the inventor has used any terms in a manner inconsistent with their ordinary meaning. In fact, the specification is the single best guide to the meaning of a term. (Vitronics Corp. v. Conceptor, Inc., 90 F.3d 1576, 1582 (Fed. Cir. 1996)).

Instantly, appellants assert that the interpretation by the examiner is not consistent with the plain language of the claims, the specification, or file history, or the interpretation of those of ordinary skill in the art. Examiner respectfully disagrees:

(a) Plain language of the claims: Clearly, the memory card is used in the process of renting a DVD, for example. That would be usage of the memory card. The information about it is each and/or all of the parameters that guide how that card may be used.

(b) The specification: No special definition is offered in the instant disclosure as originally filed, much less the specification.

(c) Prosecution history: Throughout the entire prosecution history of the instant application, appellants have continued to argue about what is NOT information about usage of a memory card. Appellants have consistently been unable to point to any location in the instant specification that limits that phrase. Appellants assert that the examples of what such usage may be should somehow limit what the phrase cannot be. Examiner respectfully disagrees.

(d) Interpretation of those skilled in the art: As discussed briefly supra, the intrinsic record is first researched for clues as to any special meanings of terms in the claims. As also discussed supra, mere examples provided the specification do not limit the claim terms to those examples, as something that may be one thing leaves wide open the possibility of it also being another. Accordingly, in the instant application, no special, limiting definitions were put forth in the intrinsic record, so examiner proceeded to extrinsic evidence. (See MPEP 2111.01 (II)). Usage is the act or manner of using. This is elaborated supra with respect to (a). Again, throughout the entire prosecution history, appellants have not presented a limiting definition any narrower than, "the act or manner of using."

Accordingly, the interpretation of the term, "information about usage of a memory card" to include a record of information stored on that memory card, about how that memory card is used, IS a reasonable interpretation of the limitation.

C. The rejection of claims 23-26 and 30-33 under 35 USC 102(e) as being anticipated by Himoto et al

1. Claims 23-26 of which claim 23 is independent

With respect to appellants' argument that examiner's interpretation of "usage of a memory card" is unreasonable, examiner refers appellants to the discussion supra with respect to the Shimizu et al rejections.

Specifically with respect to Himoto et al, however, appellants argue that the information on the LCD 14 of Himoto et al cannot reasonable be interpreted as usage of the memory card. Analogous to the reasons discussed supra with respect to Shimizu et al, examiner respectfully disagrees. The memory card is used to play games and store the scores that result from that play. Therefore, the information stored with respect to each game is usage information of the memory card. Himoto et al anticipate the claim language of claims 23-26 for at least these reasons.

2. Claims 30-33 of which claims 30 and 32 are independent

With respect to appellants' assertion that their arguments with respect to the instant claims are patentable for at least the reasons set forth with respect to claim 23, examiner respectfully disagrees, and notes that the claims are not patentable for at the reasons set forth supra in response to same.

With respect to appellants' argument that Himoto et al fail to disclose that a measurement of how full the memory is, is recorded on the memory card. Examiner respectfully disagrees. Similar to discussions supra, appellants did not provide any discussion in the instant specification of how to measure fullness. There is not a limiting definition of the term even as to quantitative or qualitative measurement. Accordingly, a visual, or qualitative, measurement is certainly a reasonable interpretation of the instant term. Himoto et al anticipate the claim language for at least this reason.

D. The rejection of claims 1-6, 8-9, 12-13, 16-17, 23, and 26 under 35 USC

103(a) as being unpatentable over Bruce et al

1. Claims 1, 3-6, 8-9, 12-13, 16-17, and 23, of which claims 1, 16, 17, and 23 are independent

With respect to appellants assertion that the flash PC card disclosed by Bruce et al cannot be considered a memory card, examiner respectfully disagrees. Both are clearly disclosed as "cards." A Flash is a particular type of memory (See class schedule and definitions for 711/101-103, e.g.). Accordingly, a flash card may, indeed, be considered a memory card – again, appellants offered no special definition or any other intrinsic evidence of record to further limit such an interpretation.

With respect to appellants' assertion that further modifying Bruce et al to include a sticker on the memory would render the device unfit for its intended purpose, examiner respectfully disagrees. As recited in the title of Bruce et al, their invention is counting the number of writes to a memory to wear-level the memory. Certainly, one of ordinary skill in the art would understand that one can count the total writes with slash marks on a sticker as opposed to in a register memory in additional circuitry, for the same intended purpose of wear-leveling the memory – when the user begins to near the total amount of writes the memory is supposed to be able to handle without error, the user would then look at the marks and save the information stored in that memory into a new memory so as not to lose the information. In addition, manual versus automated is not, in and of itself, a patentable distinction. (*In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958)).

Appellants continue by asserting that “When properly interpreted in light of the [instant] specification, the display of claim 1 precludes an interpretation as a sticker. However, once again, appellants do not point to the portion of the specification alleged to so limit the interpretation. Examiner could find no such limitation in the disclosure as originally filed. Accordingly, examiner must respectfully disagree with appellants’ argument.

The instant specification does not limit the invention to any particular type of display, such as electronic display. There is no discussion or showing in the disclosure as originally filed as to how to build, control, or operate a display – it is merely recited in the instant specification that information may be displayed. For example, the instant specification at page 8, lines 16-17 discuss the *example* of displaying information, “automatically on a display screen at a host or *potentially at the memory card*,” but do not elaborate any further as to what “automatic” displaying would entail, much less what such a “potential” display on the card would be.

Accordingly, examiner is left to reasonably interpret such a display on the card, as claimed, as being within the knowledge of one of ordinary skill in the art. A sticker would be just such a display. In fact, some display within the knowledge of ones of ordinary skill in the art would be the ONLY displays that could possibly be considered enabled and described by the instant disclosure as originally filed. Had examiner been persuaded otherwise, a rejection of the relevant claims would have been warranted under 35 USC 112, 1st Paragraph.

2. Claim 2

With respect to appellants' assertion that a power-on event requires more from a system than merely performing power on, examiner respectfully disagrees. In addition, examiner is left to wonder what, then, exactly, *does* it require? Again, appellants do not point to any further definition or limitation of the term in the disclosure as originally filed. Accordingly, examiner's interpretation of "monitoring a power-on event" to be seeing the power on is reasonable, and disclosed accordingly by Bruce et al. Anyone can clearly see that the power is on in the Bruce et al device because it can only work when power is applied, as is true with any and all electronic devices.

3. Claim 26

With respect to appellants' argument that Bruce et al do not disclose monitoring an amount of memory used or monitoring an amount of memory remaining "free," examiner respectfully disagrees. Bruce et al "monitor" all the blocks. Each block is an amount. Bruce et al count the number of writes to each block. Blocks with a write count of zero have not been written to, and are, accordingly, "free." Yet again, appellants' disclosure as originally filed contains no more in-depth limiting discussion of what "monitoring" is.

E. The rejection of claims 1-6, 8-9, 12-13, 16-17 and 20-22 under 35 USC 103(a) as being unpatentable over Shimizu et al

1. Claims 1, 3-6, 8-9, 12, 16-17 and 22 of which claims 1, 16, and 17 are independent

With respect to appellants' argument that Shimizu et al fail to disclose the claimed display, examiner respectfully notes that no assertion was made that Shimizu et al do, in fact, disclose a display on the memory card. However, in light of appellants' discussion, one could consider apparatus 710 the "memory card" (again, no special definition in the specification of what actually constitutes a memory card). Under that interpretation, the monitor could, indeed, be considered a display on the memory card. (Again, no special definition of a display in the specification).

Appellants continue to argue, however, that the obviousness of using a sticker to keep track of the card uses to rent movies does not fall within the scope of the claim terminology for the reasons discussed supra, examiner respectfully disagrees for at least the reasons also discussed supra.

2. Claim 2

With respect to appellants' assertion that a power-on event requires more from a system than merely performing power on, examiner respectfully disagrees. In addition, examiner is left to wonder what, then, exactly, *does* it require? Again, appellants do not point to any further definition or limitation of the term in the disclosure as originally filed. Accordingly, examiner's interpretation of "monitoring a power-on event" to be seeing the power on is reasonable, and disclosed accordingly by Shimizu et al. Anyone can clearly

Art Unit: 2189

see that the power is on in the Bruce et al device because it can only work when power is applied, as is true with any and all electronic devices.

3. Claim 13

With respect to appellants' argument that Shimizu et al do not disclose the limitations of claim 13, examiner respectfully disagrees. As noted in the previous Office action, see the rejection of claim 3. In addition, paragraph 10 of Shimizu et al discloses judging whether attributes match. If they do, control information is recorded (a message is sent).

4. Claim 20

With respect to appellants' argument that the limitations of claim 20 are not disclosed by Shimizu et al, examiner respectfully disagrees. "Content" may be an image. The number of times it is reproduced is clearly disclosed by Shimizu et al.

5. Claim 21

With respect to appellants' argument that the limitations of claim 21 are not disclosed by Shimizu et al, examiner respectfully disagrees. "Content" may be a music file. The number of time content is reproduced is clearly disclosed by Shimizu et al.

F. The rejection of claims 20-22 and 24-25 under 35 USC 103(a) as being unpatentable over Bruce et al

With respect to all of these claims, appellants' argument is that examiner has not provided proper motivation in the rejections, to combine Bruce et al with teachings made hackneyed in the state of the art. Examiner respectfully disagrees:

All of claim 20-22 and 24-25:

(a) These facts have already been clearly taken as admitted prior art in accordance with MPEP 2143.03(c). Appellants have not, until now, challenged this reasoning, even in light of the clear indication in the previous Office actions that it has been taken as admitted prior art.

Claims 20-22:

(b) Bruce et al disclose counting the number of writes. Music and image files are very well known types of files that are written when such content is downloaded, for example. (Formatting also, by definition, includes writing). Which ones a user chooses to save (write) are a matter of taste, as made hackneyed by the state of the art. Why would one want to keep track of the number of music files or image files written to the memory? With respect to Bruce et al, one would want to know how close they are to the memory failing so they don't lose the songs and pictures they have saved.

Claims 24-25:

With specific respect to appellants' argument that there is no motivation for one of ordinary skill in the art [*at the time of the invention*] to have included a window display or a screen display on the memory card of Bruce et al, examiner respectfully disagrees,

Art Unit: 2189

for at least the reasons discussed supra with respect to claim 1. A screen or window is not limited to an *electrical* screen or window, for example. A screen display could be a screen-printed display on the sticker. A window could easily be interpreted to be a depression on the cover of the disc with a plastic guard over it so that a user could simply slide the cardboard sticker into it, so that it doesn't tear upon entry and removal from the drive, for example.

Also, the instant disclosure as originally filed does not appear to have enabled one of ordinary skill in the art to make and/or use the claimed invention, if appellants' instant arguments were persuasive. Further, questions would be raised as to whether appellants actually had possession of the claimed invention (again, as argued instantly), as there is no description of the memory chip having a display. If it is not obvious to those of ordinary skill in the art at the time the invention was made, then why wasn't it described in sufficient detail in the instant disclosure to enable one of ordinary skill in the art to make and/or use it? Where is the evidence in the written description that appellants even had possession of this invention, if it is not well-known in the state of the art?

G. The rejection of claim 18 under 35 USC 103(a) as being unpatentable over Shimizu et al or Bruce et al, each taken separately, in view of Bueno

With respect to appellants' argument that Bueno fails to cure the deficiencies of either Shimizu et al or Bruce et al, examiner respectfully disagrees, and may only refer appellants to the rejection of same in the previous Office action, as there is not further instant discussion or explanation of their argument.

H. The rejection of claim 27 under 35 USC 103(a) as being unpatentable over Himoto et al or Bruce et al, each taken separately, in view of No


With respect to appellants' argument that No fails to cure the deficiencies of either Himoto et al or Bruce et al, examiner respectfully disagrees, and may only refer appellants to the rejection of same in the previous Office action, as there is not further instant discussion or explanation of their argument.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



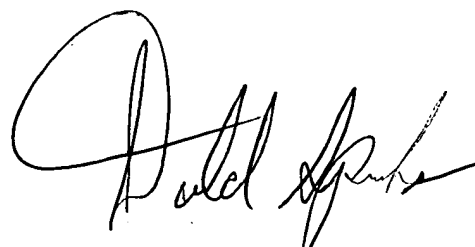
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